# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/075,380 | 02/15/2002 | Richard Brown | 30003052-2 | 7199 |

| | | | EXAMINER |
|---|---|---|---|
| 7590 | 02/24/2006 | | LASHLEY, LAUREL L |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2132 | |

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/075,380 | BROWN ET AL. |
| | Examiner | Art Unit | |
| | Laurel Lashley | 2132 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>29 November 2005</u>.

2a)☒ This action is **FINAL**.        2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2 and 5-22</u> is/are rejected.

7)☒ Claim(s) <u>3,4</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 November 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☒ Certified copies of the priority documents have been received in Application No. <u>01/039,692</u>.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### Response to Amendments

1.      Applicant's amendments with respect to claims 1 – 22 filed 29 November 2005

have been fully considered but they are not persuasive. Amendments to the abstract,

specification and claims have been accepted. Objections to the specification, drawings

and claims have been duly overcome and therefore withdrawn.

### Response to Arguments

2.      Applicant's arguments with respect to claims 1 – 22 have been considered but

are not persuasive.  Applicant's amendments have necessitated a new search and new

grounds of rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.      Claims 1, 5 -14, 18 -19 rejected under 35 U.S.C. 103(a) as being obvious over

Tychensen et al. in US Patent No. 6189097 (hereinafter US '097) in view of Apperson et

al. in US Patent No. 5978484 (hereinafter US '484).

4.      For claim 1, US '097 teaches:

A digital certificate embodied on a computer readable medium executable on a

computing system, the certificate comprising:

a credential attribute function associated with a credential attribute property, which

credential attribute property can have a plurality of values (see column 6, lines 16 and 41 – 56), but does not explicitly disclose a credential attribute function is embedded in the digital certificate as an executable program file, in which the credential attribute function can determine the value of the credential attribute property at least partly when the executable program file is executed.

Apperson et al. however does disclose a credential attribute function is embedded in the digital certificate as an executable program file, in which the credential attribute function can determine the value of the credential attribute property at least partly when the executable program file is executed (see column 2, lines 44 – column 3, lines 1 – 26; column 4, lines 28 – column 5, lines 1 – 10; column 6, lines 34 – 47; Figures 2, 4 and 5: where the credential attribute function is the CA's certificate (71) which has executable code therewithin and the CA's certificate is embedded within a digital certificate). The Examiner believes the CA's certificate to be a credential attribute function because the certificate "indicates an authorized set of privileges" which verifies levels of trustworthiness and executes code based on the level of trust identified.

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the digital certificate as taught by Tychensen et al. to comprise a credential attribute function embedded within the digital certificate as an executable program file as taught by Apperson et al., since they both disclose use of a digital certificate within the same field of endeavor (trusted communication) and with the same problem sought to be solved (determining/verifying variable trust within digital commutation).

For claim 5, US '097 teaches:

A digital certificate according to claim 1, in which the credential attribute function is configured to determine the credential attribute property value automatically (see column 12, lines 12 - 13; where there is a copy of the initial "try before you buy" function).

For claim 6, US '097 teaches:

A digital certificate according to claim 1, in which execution of the executable program file fully can determine the credential attribute property value (see column 4, lines 27 - 28 and Figure 14).

For claim 7, US '097 teaches:

A digital certificate according to claim 1, in which the executable program file is a platform portable code (see column 7, lines 55 - 58).

For claim 8, US '097 teaches:

A digital certificate according to claim 1, in which the credential attribute property comprises a value operated on by the credential attribute function to determine a credential attribute property value (see column 10, lines 27 - 33).

For claim 9, US '097 teaches:

A digital certificate according to claim 1, in which the credential attribute function uses data obtained from outside the digital certificate to determine the credential attribute property value (see column 10, lines 2 - 3; where importing indicates that data is being obtained form an external source).

For claim 10, US '097 teaches:

A digital certificate according to claim 9, in which the data obtained is obtained from a user by the input of data in response to a query generated by the credential attribute function (see column 12, lines 17 - 20).

For claim 11, US '097 teaches:

A digital certificate according to claim 9, in which the data obtained is obtained from a digital data store (see column 4, lines 46 - 47).

For claim 12, US '097 teaches:

A digital certificate according to claim 11, in which the digital data store is a web site (see column 6, lines 59 - 60).

For claim 13, US '097 teaches:

A digital certificate according to claim 1, in which there is a plurality of credential attributes in the digital certificate (see column 6, lines 41 - 56).

For claim 14, US '097 teaches:

A digital certificate according to claim 1, in which there is a plurality of credential attribute properties in the digital certificate (see column 6, lines 41 - 56).

As it relates to claim 18, US '097 teaches:

A digital certificate embodied on a computer readable medium executable on a computing system, the certificate comprising:

a credential attribute function with a credential attribute property, which credential attribute property can have a plurality of values (see column 6, lines 16 and 41 – 56), which credential attribute function is in the digital certificate as an executable program file, in which the credential attribute function can at least in part, when the executable

program file is executed, determine the value of the credential attribute property (see

column 2, lines 44 – column 3, lines 1 – 26; column 4, lines 28 – column 5, lines 1 – 10;

column 6, lines 34 – 47; Figures 2, 4 and 5: where the credential attribute function is the

CA's certificate (71) which has executable code therewithin and the CA's certificate is

embedded within a digital certificate).

It would be obvious to one of ordinary skill in the art at the time of the invention to

modify the digital certificate as taught by Tychensen et al. to comprise a credential

attribute function embedded within the digital certificate as an executable program file

as taught by Apperson et al., since they both disclose use of a digital certificate within

the same field of endeavor (trusted communication) and with the same problem sought

to be solved (determining/verifying variable trust within digital communication).

For claim 19, US '097 teaches:

A digital certificate embodied on a computer readable medium executable on a

computing system, the certificate comprising:

a credential attribute function with a credential attribute property, which credential

attribute property can have a plurality of values (see column 6, lines 16 and 41 – 56),

which credential attribute function is in the digital certificate as an executable program

file, in which the credential attribute function can at least in part, when the executable

program file is executed, determine the value of the credential attribute property

automatically (see column 2, lines 44 – column 3, lines 1 – 26; column 4, lines 28 –

column 5, lines 1 – 10; column 6, lines 34 – 47; Figures 2, 4 and 5: where the credential

attribute function is the CA's certificate (71) which has executable code therewithin and the CA's certificate is embedded within a digital certificate).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the digital certificate as taught by Tychensen et al. to comprise a credential attribute function embedded within the digital certificate as an executable program file as taught by Apperson et al., since they both disclose use of a digital certificate within the same field of endeavor (trusted communication) and with the same problem sought to be solved (determining/verifying variable trust within digital communication).

5.      Claims 2, 15 - 17 and 20 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '097 as applied to claim 1, above, further in view of Sudia in US 5,659,616 (hereinafter US '616).

As per claim 2, Sudia teaches a digital certificate according to claim 1, in which there is provided a digital certificate comprising a credential attribute and at least one credential attribute property, (see US '616, column 7, lines 26 - 28) but does not teach the digital certificate having a valid period, and a credential attribute function associated with the at least one credential attribute property, which function determines the value of the credential attribute property within the valid period.

Tyckensen et al. however does teaches the digital certificate having a valid period, and a credential attribute function associated with the at least one credential attribute property, which function determines the value of the credential attribute property within the valid period (see US '097: column 6, line 49).

For claim 2, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the digital certificate of Sudia (US '616) to comprise the characteristics of Tyckensen et al. (US '097) since they both disclose a digital certificate within the same field of endeavor (trusted communication) and with the same problem sought to be solved (restricting verification in order to meet specified criteria).

As it relates to claims 15 – 17, Tyckensen et al. teaches a digital certificate but does not explicitly teach the latter characteristics of the certificate as taught by Sudia.

For claim 15, US '097 teaches a digital certificate according to claim 14, but does not disclose a plurality of the credential attribute properties have respective attribute functions.

Sudia, however in US '616 teaches a plurality of the credential attribute properties have respective attribute functions (see column 7, lines 17 - 24; as taught by example).

For claim 16, US '097 teaches a digital certificate according to claim 15, but does not disclose that each credential attribute property has a respective attribute function.

Sudia, however in US '616 discloses that each credential attribute property has a respective attribute function (see column 6, lines 64 - 67; as taught by example).

As per claim 17, US '616 teaches the digital certificate but not that it has a valid period and the credential attribute function determines the value of the credential attribute property within the valid period.

Sudia however in US '616 discloses that it has a valid period and the credential

attribute function determines the value of the credential attribute property within the

valid period (see column 6, line 49).

For claims 15 - 17 it would be obvious to one of ordinary skill in the art at the time

of the invention to modify the digital certificate of Sudia (US '616) to comprise the

characteristics of Tyckensen et al. (US '097) since they both disclose a digital certificate

within the same field of endeavor (trusted communication) and with the same problem

sought to be solved (restricting verification in order to meet specified criteria).

As it relates to claims 20 – 22, Tyckensen et al teaches a digital certificate but

does not explicitly teach the communication of the certificate from source to sender as

taught by Sudia in US '616.

For claim 20, US '097 teaches a digital certificate but does not teaches a method

of communication, which method comprises the steps of communicating from a sender

to a recipient.

Sudia in US '616 however does teach a method of communication, which method

comprises the steps of communicating from a sender to a recipient (see column 18, line

31; where it is obvious that a communication system incorporates sending and received

of a message i.e. a certificate).

For claim 21, US '097 incorporates the communication of claim 20 but does not

teach that the recipient inspects the digital certificate and the credential attribute

property value is determined according to the credential attribute function.

Sudia however does teach that the recipient inspects the digital certificate and the credential attribute property value is determined according to the credential attribute function in US '616 (see column 9, lines 37 - 46).

Claim 22 incorporates the communication of claim 20, but does not explicitly teach that the communication is via a distributed electronic network.

In US '616 however, Sudia teaches that the communication is via a distributed electronic network (see column 1, line 19; where it is obvious that a digital certificate is an electronic document and thus it must be communicated on an electronic network).

For claims 20 - 22, it would have been obvious to one of ordinary skill in the art at the time of the invention to have known that the digital certificate of Tyckensen et al. (US '097) could perform the stated communication as disclosed by Sudia (US '616), since they both disclose a digital certificate within the same field of endeavor (digital communication) and with the same problem sought to be solved (communicating from a source to a recipient).

### *Allowable Subject Matter*

6.      Examiner maintains that claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Double Patenting*

7.      Examiner maintains the <u>provisional</u> obviousness-type double patenting rejection The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.  See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*,

418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application.  See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer.  A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

Claims 1 - 22 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1 - 38 of

copending Application No. 10/075445.  Although the conflicting claims are not identical,

they are not patentably distinct from each other because Applicant's credential attribute

function operates in the same manner as the trust function in the copending Application.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

## *Conclusion*

8.      The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fisher in US Patent No. 5412717 and 5311591, Shear et al. in US Patent No. 6292569 and Sullivan et al. in US Patent No. 6069647 disclose ideas parallel to applicant's claimed invention.

9.      Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10.     Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.
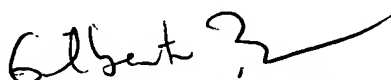
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laurel Lashley
Examiner
Art Unit 2132

16 February 2006
LLL

GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100